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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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10/616,511

07/10/2003

Bernd Misselwitz

SCH-1911

1752

23599

7590

05/19/2006

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/616,511 | <b>Applicant(s)</b><br>MISSELWITZ ET AL. |  |
|                              | <b>Examiner</b><br>D. L. Jones       | <b>Art Unit</b><br>1618                  |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-30 and 45-49 is/are rejected.  
 7) ☒ Claim(s) 31-44 and 50 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of Applicant's priority documents filed 12/28/06. In addition, the Examiner acknowledges receipt of the amendment filed 2/28/06 wherein claims 1-50 were amended.

**Note:** Claims 1-50 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments filed 2/28/06 to the rejection of claims made by the Examiner under 35 USC 101, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **101 Rejections**

The 101 rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

### **112 Rejections**

The 112 rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

### **Double Patenting Rejection**

The provisionally rejection of claims 1 and 30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 51 of copending application number 10/857,877 is MAINTAINED for reasons of record in the office action mailed 11/30/05 and those set forth below.

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Applicant asserts that the claims of the 10/857,877 are directed to a method that includes conducting MRI imaging and visualizing plaque, infarcted tissue or necrotic tissue in which a contrast agent is taken up and the instant invention is directed to MRI imaging.

Applicant's argument is non-persuasive because both methods of the pending claims are directed to MRI imaging wherein the contrast agent has the same properties, a perfluoroalkyl containing metal complex that has a critical micelle formation concentration less than 10<sup>-3</sup> mol/l; a hydrodynamic micelle diameter (2Rh) greater than 1 nanometer, and a proton relaxivity in plasma (R1) greater than 20 l/mmol-s. Thus, the skilled practitioner in the art would recognize that if the contrast agents have the same properties and are both used for the same type of imaging then, the applications contain overlapping subject matter.

## **NEW GROUNDS OF REJECTIONS**

### **Double Patenting Rejection**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-29 and 45-49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,818,203. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a method of MRI imaging wherein tissue may be visualized. The properties of the contrast agents used in each invention is the same. Furthermore, a skilled practitioner in the art would recognize the contrast agent may be used to detect both plaques and thrombi as set

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forth in specification of the instant invention (for example, see the PG publication of the instant application, US 2004/0131546, paragraph [0033]). Hence, the skilled practitioner in the art would be motivated to used the contrast agent of the instant invention for visualizing plaques as well.

### **CLAIM OBJECTIONS**

5. Claims 31-44 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **COMMENTS/NOTES**

6. It should be noted that the full scope of the instant invention has been examined. Thus, the restriction requirement has been WITHDRAWN.

7. It should be noted that no prior art has been cited in the instant invention. The closest prior art is Applicant's own work which is cited in the double patenting rejections above.

8. It is duly noted that Applicant has filed numerous application directed to similar subject matter. While every effort has been made to review the applications for overlapping subject matter, some applications may have been missed. Thus, Applicant is respectfully requested to submit a listing of all applications in the next


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correspondence to the Examiner containing overlapping subject matter for review for double patenting issues.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones  
Primary Examiner  
Art Unit 1618

May 12, 2006